

REMARKS

In the present communication, no claims have been amended, cancelled, or added. As such, Claims 1-10 and 12-15 are pending. Applicants note that Claims 1-3 and 5-9 have been allowed. As such, only Claims 4, 10, and 12-15 are at issue.

The Examiner issued a single rejection of Claims 4, 10, and 12-15. In particular, the Examiner rejected these claims under 35 U.S.C. 112, second paragraph, as allegedly indefinite. In particular, the Examiner objected to the word "derivatives" in these claims as it is allegedly unclear "what the derivative is." (Office Action, page 2). The Examiner cites the following definition of "derivative" from a *standard* Webster's dictionary as allegedly providing evidence that "derivative" in the claims is unclear:

[A] substance derived from, or of such composition and properties, that it may be considered as derived from, another substance by chemical change, esp. by the substitution of one or more elements or radicals.

Applicants disagree with this rejection and submit that the use of "derivatives" (in reference to mannose) in the claims is sufficiently precise under the law, particularly in view of the use of "mannose derivatives" in the art.

A. Legal Standard

In the Examiner's rejection, it would appear that the Examiner is requesting that the Applicants specify exactly "what the derivative is," by providing, for example, a list of specific derivatives. Applicants submit that there is no requirement under the law to list out specific mannose derivatives in order to comply with the definiteness requirement. Instead, an Examiner should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. (MPEP 2173.02, *emphasis in original*)

As explained below, Applicants submit the claim phrase "mannose derivatives" provides the reasonable degree of particularity and distinctness required under the law.

B. Art Definition of "Derivative"

As noted above, the Examiner cited a definition for "derivative" from a *standard* English dictionary, indicating that this provided evidence that "derivative" in the claims was unclear.

Applicants disagree that this definition makes the claims unclear. Regardless, Applicants submit that a standard English dictionary should not be relied on with regard to a technical chemical term such as "derivative," and instead, a chemistry based definition should be employed given the nature of the claims and the knowledge of one of skill in the art in this area. One exemplary chemistry based definition from Wikipedia is provided below:

Derivative (Chemistry)

In chemistry, a derivative is a compound that is formed from a similar compound or a compound that can be imagined to arise from another compound, if one atom is replaced with another atom or group of atoms. The latter definition is common in organic chemistry. In biochemistry, the word is used about compounds that at least theoretically can be formed from the precursor compound.

Applicants submit that this exemplary chemistry based definition provides a reasonable amount of particularity and distinctness as required under the law.

C. Use of "Mannose Derivatives" in the Art

Evidence that the phrase "mannose derivatives" is understood by those skilled in the art comes from prior issued U.S. patents. Three exemplary patents are discussed below which illustrate the use of "mannose derivatives" in the claims:

- U.S. Patent 7,238,529 - This patent describes the use of oncomodulin to treat ocular disorders. As described in the Abstract, in certain embodiments, the oncomodulin is administered with a "mannose derivative." Importantly, the issued claims of this patent use the phrase "mannose derivative." (see Claim 2).
- U.S. Patent 6,331,504 - This patent describes the treatment of crucifer seeds with solutions of sugars or polyols to improve fall seeding survival. Importantly, the issued claims of this patent use the phrase "mannose derivative." (see Claim 1).
- U.S. Patent 5,994,629 - This patent describes a positive selection technique that relies on introducing a desired nucleotide sequence and a co-introduced sequence, where the co-introduced sequence can metabolize a compound such as mannose or a mannose derivative. Importantly, the issued claims of this patent use the phrase "mannose derivative" (see Claim 4). This patent provides a description of "mannose derivatives" at column 7, lines 3-25, which is consistent with the chemistry-based "derivative" definition provided above.

D. The Claims Are Definite

In light of the discussion above regarding the legal standard and chemistry-based definition, as well the use of "mannose derivatives" in the claims of prior issued U.S. patents, Applicants submit that "mannose derivatives" in the claims provides a reasonable degree of particularity and distinctness. As such, Applicants respectfully request this rejection be withdrawn.

CONCLUSION

Should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicants encourage the Examiner to call the undersigned at 608-218-6900.

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